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APPLICATION NO. 09/037,120	FILING DATE 02/09/98	SCHOON FIRST NAMED INVENTOR D	ATTORNEY DOCKET NO. REV-98-5
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JULIE BLACKBURN
REVLON CONSUMER PRODUCTS CORPORATION
LAW DEPARTMENT
625 MADISON AVENUE
NEW YORK NY 10022

FAULKNER, J.
EXAMINER

1617
ART UNIT

PAPER NUMBER

06/23/99 7

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/037,128

Applicant

Schoon et al

Examiner

Faulkner, D.

Group Art Unit
1617



- ☐ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-28 and 25-30 is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-28 and 25-30 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claims _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of References Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

D. Faulkner

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

1. The examiner acknowledges receipt of the request for license for foreign filing, the request for the license has been granted on 12/10/98.

Claim Objections

2. Claim 25-30 are objected to because of the following informalities: The applicant has not included a claim numbered as 24. Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-10, 19-23^{and 25} are rejected under 35 U.S.C. 102(b) as being anticipated by Pagano et al (WO 97/42930).

Pagano teaches a nail composition which comprises a combination of various alkyl methacrylates including such methacrylates represented from methyl methacrylate and butyl methacrylate, with muticarbonyl vinyl monomers such as acetoacetoxyethyl methacrylate and with acrylic acids. He teaches additional plasticizers, solvents, and U.V. absorbers.

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Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 11-18 and 26-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pagano, WO 97/42930 in view of Beaver et al, US patent 5,830,442.

Pagano teaches a combination of various alkyl methacrylates including such methacrylates represented from methyl methacrylate and butyl methacrylate, with muticarbonyl vinyl monomers such as acetoacetoxyethyl methacrylate and with acrylic acids, additional plasticizers, solvents, and U.V. absorbers in a nail composition. Pagano does not teach the particular tertiary amine accelerators, nor the use of these methacrylates, plasticizers and solvents in an artificial fingernail.

Beaver teaches artificial nail compositions that comprise ethylenically unsaturated monomers with acetoacetoxyethyl methacrylate, ethylene glycol dimethacrylates. He also teaches the addition of accelerators that are aliphatic tertiary amines such as an N,N-di lower alkyl p-toluidine. Beaver includes in his nail compositions. See examples 4-8, 16 and 18-21. See also col. 5 lines 55-col. 6 line 24, and col. 4 lines 35-56.

It would have been obvious to one of ordinary skill in the art to combine the methods of producing artificial nail structures and compounds of Beaver in the compositions of Pagano.

The motivation for combining the methods and compounds of Beaver and Pagano is given by the

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fact that they are chemically equivalent compositions with slight variations in the choices of accelerators and excipients. The provide structural and functional equivalence within the state of the nail art.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CAR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CAR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CAR 3.73(b).

8. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being obvious over Pagano et al, 5,772,988.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e).

This rejection under 35 U.S.C. 103(a) might be overcome either by a showing under 37 CAR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by a showing of a date of invention for the instant application of any unclaimed subject matter prior to the effective U.S.

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filing date of the reference under 37 CAR 1.131. The combination of monomers, acetoacetoxy methacrylates and acrylic acids in a nail composition is the same as claimed by applicant.

Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pagano et al, 5,772,988

Pagano et al describes nail composition which comprises a combination of various alkyl methacrylates including such methacrylates represented from methyl methacrylate and butyl methacrylate, with muticarbonyl vinyl monomers such as acetoacetoxyethyl methacrylate and with acrylic acids He also teaches additional plasticizers, solvents, and U.V. absorbers.

9. Claims 1-10 directed to an invention not patentably distinct from claims 1-18 of commonly assigned patent and application 09037128. Specifically, the claims utilize the same combinations of monomers of methacrylates, acetoacetoxymethacrylates, and acrylic acids in compositions that are suitable for nail use.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CAR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CAR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CAR 3.73(b).

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Claims 1-10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 5,772,988. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims utilize the same combinations of monomers of methacrylates, acetoacetoxymethacrylates, and acrylic acids in compositions that are suitable for nail use.